

REMARKS

Claims 1-14 are pending. Claims 1 and 9-14 are amended. Support for the amendment to claim 1 is found in paragraph [0031] of the Specification, for example. Claims 9-14 are amended only to replace “instrument” with –apparatus—in order to better comply with antecedent basis requirements consistent with U.S. Patent practice. No new matter is submitted. Accordingly, entry of the Amendment is respectfully requested.

In the Office Action, claim 8 is rejected under 35 U.S.C. 112, 1st paragraph as allegedly failing to comply with the enablement requirement with respect to the various alternative energies recited in claim 8. Applicants submit however that the various alternative ablative energies, to wit, microwave, cryoablation, radio-frequency (RF), and laser energy, are identified in the Specification at page 5, paragraph [0023], for example. The skilled artisan would thus readily know and understand that the alternative ablative energies recited in claim 8 are readily intended for use with the device claimed based on the written description as filed. Accordingly, withdrawal of the 35 U.S.C. 112, 1st paragraph rejection of claim 8 is respectfully requested.

In the Office Action, claims 1, 5, 6, 8 and 14 are rejected under 35 U.S.C. 102(b) as allegedly anticipated over U.S. Patent No. 4,240,431 to Komiya. (hereafter “Komiya”). The rejection is respectfully traversed.

To maintain a 35 U.S.C. 102 rejection, a reference must teach each and every element of the claimed feature. Komiya does not do so.

Applicants’ independent claim 1 recites an apparatus for ablating tissue comprising, *inter alia*, first and second jaws operative to secure tissue to be ablated, the first and second jaws having a first ablation surface and a second ablation surface, and at least one of the first jaw or the second jaw having a cavity with a transducer element therein and an air backing chamber.

Komiya discloses a laser knife 61 having opposed holding members 63, 64. Holding member 63 has a spoon-shaped distal end 63b, whereas holding member 64 has a distal end 64b. A tubular retaining member 62 receives an internal tubular member 65, at least one of which is slid to urge the normally biased apart distal ends 63b, 64b to overlap one another (Fig. 17, col. 7, lines 18-30). Komiya thus fails to teach or disclose the at least one of the first jaw or the second jaw having a cavity with a transducer element therein and an air backing chamber, as recited in Applicants' claim 1. Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 5, 6, 8 and 15 based on Komiya is respectfully requested.

In the Office Action, claims 1, 4-8, 11 and 14 are rejected under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent No. 6,723,092 to Brown, et al (hereafter "Brown"). The rejection is respectfully traversed.

To maintain a 35 U.S.C. 102 rejection, a reference must teach each and every element of the claimed feature. Brown does not do so.

Applicants' independent claim 1 recites an apparatus for ablating tissue comprising, *inter alia*, first and second jaws operative to secure tissue to be ablated, the first and second jaws having a first ablation surface and a second ablation surface, respectively, and at least one of the first jaw or the second jaw having a cavity with a transducer element therein and an air backing chamber.

Brown discloses an atrial fibrillation device 10 with radio frequency electrode holders 12, 14 that each have multiple electrodes 16 arranged thereon to create a transmural lesion through tissue (Fig. 1 and col. 3, lines 40-43). Brown fails however, to teach or disclose a tissue ablating apparatus comprised of first and second jaws wherein at least one of the first jaw or the second jaw has a cavity with a transducer element therein and an air backing chamber, as recited in Applicants' independent claim 1. Brown thus fails to teach or disclose each and every feature

recited in Applicants' claim 1, from which all remaining claims ultimately depend. Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 5, 6, 8 and 15 based on Brown is respectfully requested.

In the Office Action, claims 2 and 3 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Brown in view of U.S. Patent No. 6,953,461 to McClurken, et al. (hereafter "McClurken"). The rejection is respectfully traversed.

Applicants' independent claim 1 is discussed above. Likewise, Brown is discussed above.

McClurken, is applied for allegedly teaching a cooling liquid that serves "inherently" as a heat exchanger as recited in Applicants' claims 2 and 3. McClurken, however, discloses a fluid-assisted endoscopic forceps type medical device 10 having first and second jaws 16a and 16b, respectively. Jaw 16a has electrodes 64a and 66a extending therethrough, while jaw 16b has opposing electrodes 64b and 66b extending therethrough (col. 13, lines 47-56). Thus, McClurken fails to disclose a tissue ablating apparatus comprised of first and second jaws wherein at least one of the first jaw or the second jaw has a cavity with a transducer element therein and an air backing chamber, as recited in Applicants' independent claim 1. McClurken thus fails to overcome the deficiencies of Brown in at least this regard. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejection of claims 2 and 3 based on the combination of Brown and McClurken is respectfully requested.

In the Office Action, claim 3 is rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Brown in view of U.S. Patent No. 4,074,718 to Morrison, Jr. (hereafter "Morrison"). The rejection is respectfully traversed.

Applicants' independent claim 1 is discussed above. Likewise, Brown is discussed above.

Morrison is applied for allegedly teaching the heat exchanger of Applicants' claim 3. Morrison, however, with respect to the embodiment relied on in the Office Action relying on the heat sinks 76, 78 of Morrison referred to therein, discloses an electrosurgical instrument comprised of bipolar needles 70, 72 mounted in a holder 74 (col. 7, lines 51-67). Morrison does not disclose or suggest a tissue ablating apparatus comprised of a first jaw and a second jaw wherein at least one of the first and second jaw has a cavity with a transducer element therein and an air backing chamber, as recited in Applicants' independent claim 1. Morrison thus fails to overcome the deficiencies of Brown in at least this regard. Accordingly, withdrawal of the 35 U.S.C. 103(a) rejection of claim 3 based on the combination of Brown and Morrison is respectfully requested.

In the Office Action, claims 9 and 10 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Brown in view of U.S. Patent No. 6,775,575 to Bommannan, et al. (hereafter "Bommannan"). The rejection is respectfully traversed.

Applicants' independent claim 1 is discussed above. Likewise, Brown is discussed above.

Bommannan is applied for allegedly disclosing an ablative instrument with one of its jaws having a pointed tip (226). Bommannan, however, discloses a tissue treatment system comprised of a controller 300 connected to a scissors-like treatment applicator 200. The applicator 200 has an energy application jaw 214 and a support/sensor jaw 216 opposite thereof. Treatment elements 220 are provided on inner surfaces 222, 224, or within, the opposed application jaw 214 and support/sensor jaw 216, respectively, whereby energy is provided to the treatment elements 220 from the controller 300. Bommannan thus fails to disclose a tissue ablating apparatus comprised of a first jaw and a second jaw wherein at least one of the first and second jaw has a cavity with a transducer element therein and an air backing chamber, as recited

in Applicants' independent claim 1. Accordingly, withdrawal of the 35 U.S.C. 103(a) rejection of claims 9 and 10 based on the combination of Brown and Bommannan is respectfully requested.

In the Office Action, claims 11-13 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Brown in view of U.S. Patent No. 5,626,607 to Malecki, et al. (hereafter "Malecki"). The rejection is respectfully traversed.

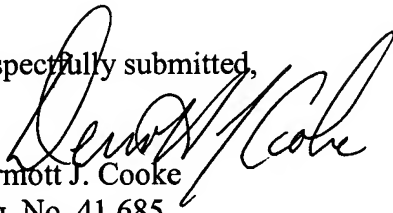
Applicants' independent claim 1 is discussed above. Likewise, Brown is discussed above.

Malecki discloses various embodiments of a clamping device 20 with a fixed jaw 30 and a movable jaw 32 (Fig. 1), clamping device 64 and jaws 82, 84 (Fig. 3), or clamping device 304 and jaws 308, 310 (Fig. 17), for example, between which the aorta may be gripped (col. 7, lines 44-48). Malecki, however, fails to disclose or suggest a tissue ablating apparatus comprised of a first jaw and a second jaw wherein at least one of the first and second jaw has a cavity with a transducer element therein and an air backing chamber, as recited in Applicants' independent claim 1 from which claims 11-13 ultimately depend. Malecki thus fails to overcome the deficiencies of Brown in at least this regard. Accordingly, withdrawal of the 35 U.S.C. 103(a) rejection of claims 11-13 based on the combination of Brown and Malecki is respectfully requested.

Applicants submit that the claims presented patentably distinguish over the art applied. Accordingly, prompt allowance of the application in view of the remarks set forth herein is respectfully requested.

Should the Examiner determine that anything further is desirable to place this application in even better form for allowance, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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